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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,982	01/26/2006	Melchor Daumal Castellon	001058-00031	9466
27557 7590 08/16/2011 BLANK ROME LLP WATERGATE 600 NEW HAMPSHIRE AVENUE, N.W. WASHINGTON, DC 20037				
EXAMINER				
DIAZ, THOMAS C				
ART UNIT		PAPER NUMBER		
3656				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,982

Applicant(s)

DAUMAL CASTELLON, MELCHOR

Examiner

THOMAS DIAZ

Art Unit

3656

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2010 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-942)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/15/2011 has been entered.

Specification

The amendment filed 12/27/2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Figure 7 along with disclosure for figure 7 within the specification is considered new matter since the figure contains specific dimensioning and positioning of the deformations which were not originally disclosed in the disclosure. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiche et al. (USP 7174803) in view of Schwarzhich (USP 6942417).

Regarding claim 13, Reiche et al. discloses a similar device comprising a female member (fig.5, 3) slidably receiving a male member (fig.5, 2) therein, said female and male members having a substantially triangular shape with blunt vertexes (see fig.6, both are substantially triangular and have blunt vertices); a plurality of metal strips (fig.5, 9) separate from said male member, each of said metal strips having an uneven contact surface (the strips are bowed or not flat and thus read on having an uneven contact surface, furthermore, the contact surface inherently has some degree of surface roughness and thus is uneven); and a continuous fastening cage (figures 5 and 6, cage 7) fitted between said female member and said male member, said fastening cage having sides corresponding to sides of said triangular shape (see fig.6, the sides which would hold members 4) of said female and male members, said fastening cage having a recess (fig.5, recess arranged on a side of the cage and which holding elements 9), said metal strip arranged in said recess (see fig.5).

Reiche et al. fails to explicitly disclose a plurality of recesses, each of said recesses being individually arranged on said sides of said fastening cage, respectively, corresponding to said sides of said triangular shape, and wherein each of said metal strips being received in each of said plurality of recesses, respectively, such that said metal strips are distributed on each of said sides of said triangular shape of said female and male members.

Schwarzhigh teaches the concept of using a plurality of recesses (recesses 26 for spring elements 18), each of said recesses being individually arranged on said sides of a fastening cage (20), respectively, corresponding to said sides of said triangular shape (see fig.1), and wherein each of a plurality of metal strips or springs being received in each of said plurality of recesses (see fig.1), respectively, such that said metal strips are distributed on each of said sides of said triangular shape of said female and male members (seen in figure 1) for the purpose of providing a mechanism which reduces the clearance during rotation between the telescopic parts of the steering mechanism and provides a symmetrical transfer of steering torque between the members without hindering the axial adjustment of the steering wheel (col.1, lines 22-34).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the cage with one metal strip and recess disclosed by Reiche et al. to include a plurality of recesses, each of said recesses being individually arranged on said sides of said fastening cage, respectively, corresponding to said sides of said triangular shape, and a plurality of metal strips being received in each of said plurality of recesses, respectively, such that said metal strips are distributed on each of said sides of said triangular shape of said female and male members, as taught by Schwarzhigh, for the purpose of providing a mechanism which reduces the clearance during rotation between the telescopic parts of the steering mechanism and provides a symmetrical transfer of steering torque between the members without hindering the axial adjustment of the steering wheel. Furthermore, the

use of additional strips and recess in the device of Reiche is a mere duplication of the essential working parts, which is shown in Schwarzhich, and the addition of extra fastening members is within the level of ordinary skill in the art.

Regarding claim 14, Reiche et al. discloses said cage is clamped to the outside of said male member by deformations (the male members lateral surfaces are deformed or curved inwardly which aid in providing the clamping force for the fastening cage) on a lateral side thereof.

Regarding claim 15, Reiche et al. discloses said male member has blunt surfaces (see fig.6).

Response to Arguments

Applicant's arguments with respect to claims 13-15 have been considered but are moot in view of the new ground(s) of rejection.

Regarding the traversal of the specification objection for new matter, the Examiner respectfully disagrees with Applicant's arguments and maintains the objection.

As stated previously, figure 7 contains specific dimensioning and positioning of the deformations which were not originally disclosed in the disclosure. The original disclosure mentions a "cage (11) is clamped to the male member (4) by means of protrusion- like deformations (not shown) on the lateral surface thereof." However, this disclosure does not provide details of the specific positioning or location of the deformations nor does it provide support for the quantity of deformations nor the exact structure and shape of the deformations, as illustrated in figure 7.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS DIAZ whose telephone number is (571)270-5461. The examiner can normally be reached on Monday-Friday 7:30am to 4:00pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571)272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES PILKINGTON/
Primary Examiner, Art Unit 3656

/Thomas Diaz/
Examiner, Art Unit 3656